

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Shutt et al.

Serial No.: 09/056,289

Filed: April 7, 1998

For: Polymerization Process

BEFORE THE EXAMINER:

F. Teskin

Group Art Unit No.: 1713

Attorney Docket No.: 98B017/3

Baytown, Texas

**Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

**REQUEST TO WITHDRAW NOTICE OF IMPROPER REQUEST FOR
CONTINUED EXAMINATION**

Dear Sir,

Applicant respectfully requests withdrawal of the Notice of Improper Request for Continued Examination (RCE) for the application identified above. Applicant submits that the Office mistakenly regards the instant CPA as an RCE.

The pertinent facts are as follows:

1. A Notice of Allowance dated May 9, 2000 was received by Applicant on May 12, 2000;
2. The issue fee was due on August 9, 2000. The issue fee was not paid.
3. A proper Continued Prosecution Application (CPA) was timely filed on August 9, 2000.
4. The CPA was received by the USPTO and entered in to the U.S. Patent Office docket system with a date of August 9, 2000 (See attached PAIR printout).

*TC

3-18-05

6. A Notice of Abandonment for USSN 09/056,789 was improperly mailed to the Applicant.
7. A Petition to Revive an Unavoidably Abandoned Application 37 CFR § 1.137(a) was granted on July 19, 2004 and the application was forwarded to Art Unit 1713 for examination in due course.
8. On December 10, 2004 Applicant received a Notice of Improper Request for Continued Examination (RCE) stating that Applicant's CPA was being treated as an RCE and that the RCE was not accompanied by a submission as required under 37 CFR § 1.114.

Applicant respectfully disagrees with the holding that the CPA should be treated as an RCE and requests that the Notice of Improper Request for Continued Examination (RCE) be withdrawn and the instant application be examined under the procedures set forth in prior 37 CFR § 1.53(d) as required by MPEP § 201.06(d)I.

MPEP § 201.06(d)I. states in relevant part: "*CPA's filed prior to July 14, 2003 will continue to be processed and examined under the procedures set forth in prior 37 CFR § 1.53(d).*(emphasis added)" Likewise MPEP § 201.06(d)I.A. states in relevant part: "*If a utility or plant application has a filing date on or after June 8, 1995, an improper CPA filed on or after July 14, 2003 will be treated as a request for continued examination (RCE) under 37 CFR 1.114.*(emphasis added)" Note also that under MPEP § 201.06(d)I. "*Any request for CPA filed on or after July 14, 2003... is improper, regardless of the filing date of the ...application....*"

Applicant respectfully submits that the CPA filed in the instant application on August 9, 2000 was proper at the time it was filed and is thus now proper. First the CPA was entered in the PAIR system, second there has been no finding by the USPTO that the CPA does not meet the requirements of 37 CFR § 1.53(d) and third, all the requirements of 37 CFR § 1.53(d) as in effect on August 9, 2000 have, in fact, been met. Specifically, 37 CFR § 1.53(d)(1), as set out in the white volume 37 of the Code of Federal Regulations (CFR) revised July 1, 2000, states

that "(1) A continuation... of a prior non-provisional application may be filed as a continued prosecution application..., provided that:

(i)(A). The prior utility application was filed under 35 USC § 111(a) before May 29, 2000; Applicant's prior utility application was filed as a regular application under 35 USC § 111 (a) on April 7, 1998, well before May 29, 2000, and

(i)(A). The prior utility application is complete as defined by § 1.51(b); Applicant's prior application was found allowable on May 9, 2000 which is *prima facie* evidence that the application was found by the USPTO to be complete, and

(ii). The [CPA] application is filed before the earliest of payment of the issue fee, abandonment of the prior application, or termination of proceedings on the prior application; Applicant's CPA was filed on August 9, 2000, the date the issue fee was due, thus the CPA was timely filed.

Further 37 CFR § 1.53(d)(2) requires an application filed under [§ 1.53(d)] must:

(i) identify the prior application; Applicant identified the prior application on page 1 of 3 of the formal papers filed August 9, 2000 requesting the CPA. The CPA was entered into the correct PAIR file in the USPTO PAIR database (as indicated in the PAIR printout), therefore we can conclude the prior application was identified sufficiently, and

(ii) disclose and claim only subject matter disclosed in the prior application; Applicant has not added or claimed any new matter in the instant application as compared to the prior application, and

(iii) name the same inventors as the prior application; The inventors are the same on both the prior application and instant application, and

(iv) include a request for application under 37 CFR § 1.53(d); such request is made on page 1 of 3 of the formal papers filed August 9, 2000 requesting the CPA.

Further 37 CFR § 1.53(d)(3) requires payment of the basic fee and any additional fees for extra claims. Applicant paid a filing fee of 3,168 dollars (690 for the basic fee and 2478 for extra claims).

As shown above, Applicant has met all the requirements of 37 CFR § 1.53(d) as in force on August 9, 2000 when the instant application was filed. Therefore the CPA was proper. Thus under MPEP § 201.06(d)I, the instant application must continue to be processed and examined under the procedures set forth in prior 37 CFR § 1.53(d) as a continued prosecution application and NOT be treated as a request for continued examination (RCE).

Therefore, since the instant application is a proper CPA, it did not need to have a submission as required under 37 CFR § 1.114 for RCE's. Hence, Applicant respectfully requests the Office withdraw the Notice of Improper Request for Continued Examination (RCE) and place the instant application in the queue for examination.

A copy of the Notice of Improper Request for Continued Examination (RCE) is attached and a copy of the PAIR print out is attached.

Please charge any fee necessary for the instant request or during the pendency of this application to USPTO Deposit Account 05-1712.

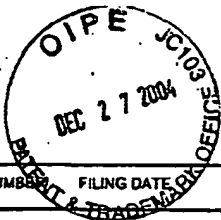
December 27, 2004

Date

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Baytown, Texas 77522-2149
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Respectfully submitted,


Catherine L. Bell
Registration No. 35,444



Commissioner for Patents
United States Patent and Trademark Office

P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

APPLICATION NUMBER

FILING DATE

FIRST NAMED APPLICANT

ATTY. DOCKET NO./TITLE

DATE MAILED:

NOTICE OF IMPROPER REQUEST FOR CONTINUED EXAMINATION (RCE)

The request for continued examination (RCE) under 37 CFR 1.114 filed on 8/9/00 is improper for reason(s) indicated below:

- ☐ 1. Continued examination under 37 CFR 1.114 does not apply to an application for a design patent. Applicant may wish to consider filing a continuing application under 37 CFR 1.53(b) or a CPA under 37 CFR 1.53(d). An RCE cannot be treated as a CPA.
- ☐ 2. Continued examination under 37 CFR 1.114 does not apply to an application that was filed before June 8, 1995. Applicant may wish to consider filing a continuing application under 37 CFR 1.53(b).
- ☐ 3. Continued examination under 37 CFR 1.114 does not apply to an application unless prosecution in the application is closed. If the RCE was accompanied by a reply to a non-final Office action, the reply will be entered and considered under 37 CFR 1.111. If the RCE was not accompanied by a reply, the time period set forth in the last Office action continues to run from the mailing date of that action.
- ☐ 4. The request was not filed before payment of the issue fee, and no petition under 37 CFR 1.313 was granted. If this application has not yet issued as a patent, applicant may wish to consider filing either a petition under 37 CFR 1.313 to withdraw this application from issue, or a continuing application under 37 CFR 1.53(b).
- ☐ 5. The request was not filed before abandonment of the application. The application was abandoned, or proceedings terminated on _____. Applicant may wish to consider filing a petition under 37 CFR 1.137 to revive this abandoned application.
- ☐ 6. The request was not accompanied by the fee set forth in 37 CFR 1.17(e) as required by 37 CFR 1.114. Since the application is not under appeal, the time period set forth in the final Office action or notice of allowance continues to run from the mailing date of that action or notice.
- ☒ 7. The request was not accompanied by a submission as required by 37 CFR 1.114. Since the application is not under appeal, the time period set forth in the final Office action or notice of allowance continues to run from the mailing date of that action or notice.

Note: A continued prosecution application (CPA) under 37 CFR 1.53(d) cannot be filed in a utility or plant application. A CPA filed in a utility or plant application that has a filing date on or after June 8, 1995 will be treated as an RCE under 37 CFR 1.114. The request for a CPA in the instant application, however, has been treated as an improper RCE for the reason(s) indicated above.

A copy of this notice MUST be returned with any reply.

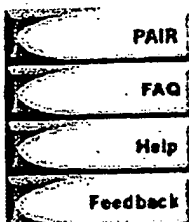
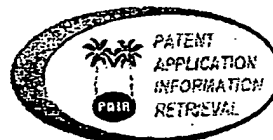
Direct the reply and any questions concerning this notice to:

Louise Bell, Technology Center 1700

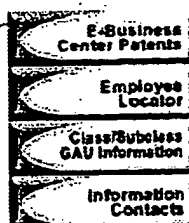
(703) 30 _____



PATENT APPLICATION INFORMATION RETRIEVAL



Other Links



Search results for application number: 09/056,289			
Application Number:	09/056,289	Customer Number:	23455
Filing or 371(c) Date:	04-07-1998	Status:	Abandoned - Failure to Pay Issue Fee
Application Type:	Utility	Status Date:	10-02-2000
Examiner Name:	TESKIN, FRED M	Location:	FILE REPOSITORY (FRANCONIA)
Group Art Unit:	17.13	Location Date:	07-09-2001
Confirmation Number:	5091	Earliest Publication No:	-
Attorney Docket Number:	98B017/2	Earliest Publication Date:	-
Class/ Sub-Class:	526/071	Patent Number:	-
First Named Inventor:	JOHN R. SHUTT, HOUSTON, TX (US)	Issue Date of Patent:	-
Title Of Invention:	POLYMERIZATION PROCESS		

Foreign Priority

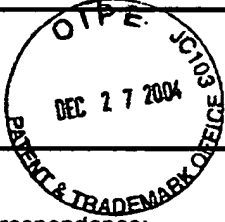
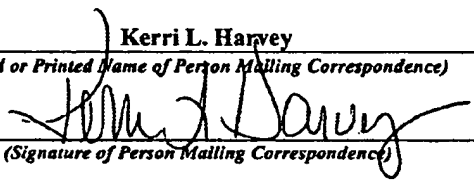
Continuity Data

File Contents History

Number	Date	Contents Description
22	06-29-2000	Workflow - File Sent to Contractor
21	10-02-2000	Mail Notice of Abandonment from Publications
20	10-02-2000	Abandonment for Failure to Pay Issue Fee
19	08-09-2000	Workflow - Request for CPA - Begin
18	05-09-2000	Mail Notice of Allowance
17	05-09-2000	Notice of Allowance Data Verification Completed
16	05-08-2000	Notice of Allowability
15	03-01-2000	Date Forwarded to Examiner
14	02-22-2000	Response after Non-Final Action
13	02-22-2000	Request for Extension of Time - Granted
12	09-13-1999	Information Disclosure Statement (IDS) Filed
11	10-07-1999	Mail Non-Final Rejection
10	10-01-1999	Non-Final Rejection
9	06-16-1999	Case Docketed to Examiner in GAU
8	09-25-1998	Information Disclosure Statement (IDS) Filed
7	11-12-1998	Case Docketed to Examiner in GAU
6	06-02-1998	Application Dispatched from OIPE
5	05-29-1998	Application is Now Complete
4	05-08-1998	Notice Mailed--Application Incomplete--Filing Date Assigned
3	05-04-1998	IFW Scan & PACR Auto Security Review

2	05-04-1998	IFW Scan & PACR Auto Security Review
1	04-09-1998	Initial Exam Team nn

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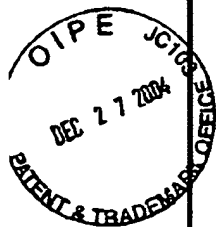
CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10) Applicant(s): Shutt, et al.			Docket No. 98B017/3	
Application No. 09/056,289	Filing Date April 7, 1998	Examiner F. Teskin	Customer No. 23455	Group Art Unit 1713
Invention: Polymerization Process				
<div style="text-align: center;"></div>				
I hereby certify that the following correspondence:				
<div style="border: 1px solid black; padding: 5px;">Transmittal Form, Request to Withdraw Notice of Improper Request for Continued Examination, Copy of Notice of Improper Request for Continued Examination (RCE), Copy of Patent Application Information Retrieval, and Postcard</div>				
<i>(Identify type of correspondence)</i>				
is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on				
<u>December 27, 2004</u> <i>(Date)</i>				
<u>Kerri L. Harvey</u> <i>(Typed or Printed Name of Person Mailing Correspondence)</i>				
 <i>(Signature of Person Mailing Correspondence)</i>				
<u>EV366446220US</u> <i>("Express Mail" Mailing Label Number)</i>				
Note: Each paper must have its own certificate of mailing.				

12-28-01

PTO/SB/21 (04-04)

Approved for use through 07/31/2006. OMB 0651-0031
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

TRANSMITTAL FORM (to be used for all correspondence after initial filing)		Application Number	09/056,289
		Filing Date	April 7, 1998
		First Named Inventor	Shutt, et al.
		Art Unit	1713
		Examiner Name	F. Tesdn
Total Number of Pages in This Submission	8	Attorney Docket Number	98B017/3

ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Request to Withdraw Notice of Improper Request for Continued Examination, Copy of Notice of Improper Request for Continued Examination (RCE), Copy of Patent Application Information Retrieval,
Remarks and Postcard		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Catherine L. Bell Registration No. 35,444
Signature	
Date	December 27, 2004

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Typed or printed name	Kerli L. Harvey	Date	December 27, 2004
Signature			

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.